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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/729,606

12/05/2003

Allen C. Thompson

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AGILENT TECHNOLOGIES INC.

INTELLECTUAL PROPERTY ADMINISTRATION,LEGAL DEPT.

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LOVELAND, CO 80537

EXAMINER

RAMILLANO, LORE J

ART UNIT

PAPER NUMBER

1743

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/17/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/729,606

Applicant(s)

THOMPSON ET AL.

Examiner

Lore Ramillano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19-24, 27 and 30-37 is/are pending in the application.
- 4a) Of the above claim(s) 20-24, 27 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19 and 31-37 is/are rejected.
- 7) ☒ Claim(s) 34 and 35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. In applicant's reply filed on 10/23/06, applicant amended claims 1-17 and 31; cancelled claims 18, 25-26, and 28-29; and added new claims 34-37. Claims 20-24, 27, and 30 are withdrawn. Claims 1-17, 19-24, 27, and 30-37 are pending in the application. Claims 1-17, 19, and 31-37 are under examination.

### **Response to Amendment**

2. In light of applicant's amendments, new rejections follow. However, the basis of the rejections over the prior art is maintained.

### **Claim Objections**

3. Claims 34 and 35 are objected to because of the following informalities: "ithin" is misspelled in claim 34; and "rotatble" is misspelled in claim 35. Appropriate corrections are required.

### **Claim Rejections - 35 USC § 112**

4. In the prior Office Action, the rejection of claims 1-17, 19, and 31-37, under 35 U.S.C. 112, second paragraph, is withdrawn. In light of applicant's amendments, a new rejection follows.

Claims 1-17, 19, and 31-37 are rejected under 35 U.S.C. 112, second paragraph, because it cannot be determined whether the "flexure" element recited in claims 1 and 17 is referring to a separate element, i.e. flexure array assembly, or characterizing the behavior of a structural element (as a flexure property). Because flexure is considered in engineering mechanics to be characterizing the behavior of a structural element,

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which is subjected to a lateral load, the flexure term recited by applicant does not seem to be claiming a structural element.

Furthermore, claims 1 and 17 are rejected because it is unclear as to what applicant is claiming in section (d) of claim 1 and section (f) of claim 17 since applicant uses the terms "interacts" and "when." When applicant is claiming an apparatus and uses functional language (i.e. interacts) that claims what the apparatus does, the prior art reads on the functional language as long as the device of the prior art is capable of performing that function. Also, when applicant claims conditional language (i.e. when) in an apparatus claim, it makes the claim unclear since its based on possible events. Examiner suggests using the following language (if supported by applicant's specification) to clarify applicant's claims, i.e. in a first position, wherein the clamping member . . . ; in a second position, wherein the clamping member . . .

### **Claim Rejections - 35 USC § 102**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1-8, 14-17, 19, and 31-33** are rejected under 35 U.S.C. 102(b) as being anticipated by Freeman (US 5958760).

Freeman discloses various devices in Figs.15a and 15b; and 13a and 13b, comprising a base (202); a cover (210); a clamping member (218); and spring elements (212 and 214) that interact with the clamping member. The cover (210) is provided with

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an upper and lower spring-loaded elements (212 and 214). Freeman further discloses a device comprising a base (114); a cover (128); an array assembly (116); a backing element (6); spacers (118); a hardstop (115); a screw stop (126); a screw (124), which when actuated, it contacts the cover; and spacers (118).

Freeman further discloses that the force from the clamping member is dissipated over a greater area of the of the array assembly, which creates a capillary gap between the array assembly and backing element (Figures 13a and 13b, column 11, 55-65). Additionally, the travel of the base and cover are limited when are the sealed together by the clamping member (column 3, lines 3-29).

### **Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. **Claims 1, 9-17, 19, 31-37** are rejected under 35 U.S.C. 103(a) as being obvious over Shea et al. ("Shea," US Pub. No. 20030235906).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

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In Figs. 7A-7D, Shea discloses various compression devices (30), which comprise a base (34), a cover (32), a clamping member (35), an array assembly (array substrate), and a backing element. Shea further disclose that the compression device is configured to apply a compression force by the actuation of cam lever (35) [0079]-[0082]. In Figs. 8A-8C, Shea discloses a device comprising a bridge having at least two extending arm portions, which comprise shoulders and terminate in feet portions, a bore; and a rotatable screw disposed within the bridge. When the rotatable screw is actuated, the screw contacts the cover. The feet portions contact the underside of the base. (i.e. [0084]-[0086]).

Shea also discloses that the compression device (30) is configured to limit the travel of at least the base and the cover when they are operatively held together by tabs (hardstop) for limiting travel [0079]-[0082].

While Shea does not specifically disclose having a flexure, Shea's base and cover are made of materials, which include plastics such as polytetrafluoroethylene, polypropylene, polystyrene, polycarbonate, PVC, and blends thereof, stainless steel and alloys thereof, siliceous materials, e.g., glasses, fused silica, ceramics and the like ([0073]). The materials (or chemical compositions) disclosed by Shea to make his base and cover are the same materials disclosed by applicant to make applicant's base and cover, which enable the base and cover to have flexure. Applicant should note that products of identical chemical composition cannot have mutually exclusive properties. Thus, because Shea discloses the same chemical composition to make its cover and

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base, the properties (i.e. flexure) applicant discloses and/or claims are necessary present in Shea.

### **Response to Arguments**

11. Applicant's arguments filed 10/23/06 have been fully considered but they are not persuasive.

In response to applicant's argument that Freeman does not indicate that the clamping plate interacts with the clamping member such that when the clamping member is actuated a force is applied to the retaining member and support or base in a manner sufficient to produce a substantially uniform distance between the retaining member and the support or base along the entire length of the retaining member and support or base, examiner disagrees. Applicant argues a function, which appears to be inherent to the clamping mechanism of Freeman. It would appear that the clamping mechanism of Freeman is capable of performing this function. As applicant is claiming an apparatus, which appears to be met by the apparatus of Freeman, then Freeman's capability is all that is necessary.

Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the distance between an opposing base and cover will be smallest at the region nearest the area where force is applied and greater at distances further away from this region) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).



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In response to applicant's argument that Shea does not disclose a flexure or spring element, examiner disagrees. While Shea does not specifically disclose having a flexure, Shea's base and cover are made of materials, which include plastics such as polytetrafluoroethylene, polypropylene, polystyrene, polycarbonate, PVC, and blends thereof, stainless steel and alloys thereof, siliceous materials, e.g., glasses, fused silica, ceramics and the like ([0073]). The materials (or chemical compositions) disclosed by Shea to make his base and cover are the same materials disclosed by applicant to make applicant's base and cover, which enable the base and cover to have flexure. Applicant should note that products of identical chemical composition cannot have mutually exclusive properties. Thus, because Shea discloses the same chemical composition to make its cover and base, the properties (i.e. flexure) applicant discloses and/or claims are necessary present in Shea.

### Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lore Ramillano whose telephone number is (571) 272-7420. The examiner can normally be reached on Mon. to Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit 1743

1/5/07

  
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